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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 11/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,792

Applicant(s)

BERNARD ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 10-14, 23-42 and 71-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-22, 43-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicant's response of 14 August 2002 (Paper No. 7) is entered. Claims 1-76 are pending.

Election/Restrictions

The requirement for restriction and election of species is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of Group I (claims 1-70) in Paper No. 7 is acknowledged. The traversal is on the grounds that the Examiner has not shown that examining Groups I and II together constitutes a serious burden due to the identical classification in patent literature. This is not found persuasive because the search encompasses non-patent literature and the search required for Group II is not required for Group I. Claims 71-76 are withdrawn as directed to a non-elected invention.

Applicant's election with traverse of the species of polymer obtained from six named monomers, as well as propylene glycol n-butyl ether and diethyl sebacate as first and second solvents, respectively, is acknowledged. The traversal is on the same grounds as the traversal to the restriction requirement. This is not found persuasive in that the number of possible combinations of species is vast. Applicant's expectation that other species will be considered if the elected species is found patentable is acknowledged.

The composition comprising propylene glycol n-butyl ether, diethyl sebacate, and a polymer obtained by polymerization of acrylic acid, n-butyl acrylate, lauryl acrylate,

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methacrylate, tert-butyl actylate, and styrene is free of the prior art. The closest art is Witteler et al (WO 01/13863 A2), which discloses the elected species of polymer (see Table 2, Example 2C, page 19) in cosmetic compositions that include plasticizers, but the reference is not available as prior art due to a publication date of 1 March 2001.

As the combination of elected species is free of the art, the search is expanded to consider additional embodiments of the claims. Claims 10-14, 23-42 are withdrawn as directed at non-elected species.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 15-22, and 43-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6, 9, and 70 are rejected for being confusing due to the use of the phrase "minimum film-forming temperature (MFT)". The MFT of a composition depends on the monomeric units in the polymer, as well as the particle size of the polymer, and is also influenced by the presence of water, emulsifiers, and organic solvents that can act as plasticizers. Therefore, applicant's use of the MFT to define a polymer is inconsistent with the actual definition and properties of minimum film-forming temperatures. In other words, the MFT (or even Tg-MFT) cannot define a polymer, where the MFT actually depends on a variety of factors and components independent of the polymer.

Claim 9 is rejected for being confusing due to the phrase "film-forming cosmetic composition comprising: a film-forming composition comprising." The rejection can be overcome by removing the duplicate part of the phrase.

Claim 38 is rejected for being confusing due to the limitations on monomer (d). Monomer (d) is required to be present, but is also stated to be present in an amount ranging from a lower limit of zero. The claim can be clarified by inserting the term "optionally" before the definition of (d), or by changing the range of (d) to "ranging from greater than 0", assuming support exists in the specification for one of these changes.

Any remaining claims are rejected for depending from an indefinite base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 15-22, and 43-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al (US Pat. 5,965,116).

The instant invention is drawn to a composition comprising a copolymer latex combined with two organic solvents. A variety of solvents are claimed based on their boiling point. Weight percentages of the monomeric constituents of the copolymer are claimed. Additional components suitable for formulating a cosmetic composition, particularly a nail varnish, are claimed.

Mondet teaches cosmetic compositions comprising a copolymer comprising at least three different monomers and having glass transition temperatures greater than 15° Celsius (see especially claim 11). It is noted that a polymer from the prior art that has the same chemical composition as claimed in the instant application necessarily has the same physical properties. The copolymers of Mondet contain unsaturated carboxylic acid monomers, (meth)acrylic acid ester monomers, and vinyl monomers (see Examples 1-3, 11, and 12). A range of weight percentages of the monomers are presented (see col. 2, lines 13-60). While applicant claims organic solvents as additives in the instant claims, the same substances are alternately known as plasticizers in the prior art. For example, Mondet teaches the use of diethylene glycol butyl ether as a plasticizer, as well as the use of dibutyl adipate. The use of plasticizers in conjunction with the copolymer is claimed (see claim 18). While Mondet does not disclose the boiling points of the plasticizers, the compounds taught by Mondet necessarily meet the claimed boiling points, since the actual compounds are the same as claimed in the instant application, and a compound has the same physical properties whether the

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compound is described as a solvent or a plasticizer. Compositions in the form of products for making up the nails such as nail varnishes are taught. Example 11 discloses a mascara comprising particles of an aqueous dispersion of copolymer. Conventional cosmetic additives are taught, such as pigments, thickeners, and additives. While Mondet claims the use of at least one plasticizer, the reference lacks specifically claiming two plasticizers, as well as the same range of weight percentages of components as claimed, as well as the full scope of components as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Mondet by routine optimization of weight percentages in order to benefit from the formulation of nail varnishes and lacquers. The motivation for the additional components comes from Mondet, which teaches that cosmetic additives such as pigments, thickeners, and additives are conventionally added when formulating nail lacquers. The missing ingredients have art-recognized suitability for the intended purpose of formulating a nail lacquer. The selection of a known material based on its suitability for its intended use has been determined to be *prima facie* obvious. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and MPEP 2144.07.

Conclusion

The combination of the elected species of polymer obtained from six named monomers, as well as propylene glycol n-butyl ether and diethyl sebacate as first and

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second solvents, respectively, is free of the prior art. The closest art is Witteler et al (WO 01/13863 A2), which discloses the elected species of polymer (see Table 2, Example 2C, page 19), but the reference is not available as prior art due to a publication date of 1 March 2001.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

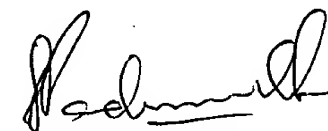
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
November 4, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

11/4/02